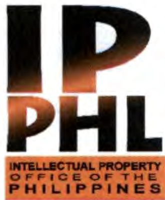

MERCK KGAA, *Opposers,*	}	**IPC NO. 14-2011-00211** Appln. No. 4-2010-004174 Date Filed: 20 April 2010
- versus -	}	TM – **"EUROX"**
D.B. MANIX INTERNATIONAL, INC., *Respondent-Applicant.*	}	

x---x

NOTICE OF DECISION

BUCOY POBLADOR & ASSOCIATES
Counsel for Opposer
21st FLOOR, Chatham House
116 Valero corner Rufino Streets
Salcedo Village, Makati City

D.B. MANIX INTERNATIONAL, INC.
Respondent-Applicant
67 Scout Fuentabella Street
Tomas Morato, Quezon City

GREETINGS:

Please be informed that Decision No. 2016 - 372 dated October 10, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 10, 2016.

MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs

IP PHL
INTELLECTUAL PROPERTY OFFICE OF THE PHILIPPINES

MERCK KGAA,
Opposer,

-versus-

D.B. MANIX INTERNATIONAL, INC.,
Respondent-Applicant.
x -- x

IPC No. 14-2011-00211
Opposition to Trademark
Application No. 4-2010-004174
Date Filed: 20 April 2010
Trademark: **"EUROX"**

Decision No. 2016-372

DECISION

Merck KGaA[1] ("Opposer") filed an opposition to Trademark Application Serial No. 4-2010-0004174. The application, filed by The D.B. Manix International, Inc.[2] ("Respondent-Applicant"), covers the mark "EUROX" for use on *"pharmaceutical product categorized as anti-infectives"* under Class 05 of the International Classification of Goods[3].

The Opposer anchors its opposition on Section 123.1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). It maintains that it registered the mark "EUTHYROX" as evidenced by Certificate of Registration No. 4-1999-001481 issued on 20 January 2003. It contends that the Respondent-Applicant's marks "EUROX" is visually and phonetically similar to its mark "EUTHYROX" as likely to cause confusion, mistake and deception to the public as to the source or origin of the goods. In support of its opposition, the Opposer submitted the following as evidence:

1. joint affidavit of Dr. Marti Andre and Ulrich Fogel, principal officers of the Opposer;
2. printout of the trademark registration of "EUTHYROX";
3. printout of the trademark registration of "EURAX"; and
4. printout of trademarks published for opposition on 14 March 2011.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 18 June 2011. The latter, however, did not file an Answer. On 13 September 2016, the Hearing Officer issued Order No. 2016-1494 declaring the Respondent Applicant in default and submitting the case for decision.

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[1] A German partnership with address at Frankfurter Strabe 250, 64271 Darmstadt, Germany.
[2] With known address at No. 67 Scount Fuentabella Street, Tomas Morato, Quezon City, Philippines.
[3] The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks concluded in 1957.

The issue to be resolved is whether the mark "EUROX" should be registered in favour of Respondent-Applicant.

Section 123.1 (d) of the IP Code provides that:

"123.1. A mark cannot be registered if it:

(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

(i) The same goods or services, or
(ii) Closely related goods or services, or
(iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion; xxx."

Records show that at the time the Respondent-Applicant filed the contested application, the Opposer has a valid and existing registration for the mark "EUTHYROX" under Certificate of Registration No. 4-1999-001481 issued on 20 January 2003.

But are the competing marks, as shown below, confusingly similar?

EUTHYROX	EUROX
Opposer's mark	*Respondent-Applicant's mark*

Perusing the competing marks, it appears that the Respondent-Applicant merely omitted the second syllable "THY" in the Opposer's mark in arriving at the mark "EUROX". Despite the same, the two marks remain visually and phonetically similar. After all, confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close or ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchased as to cause him to purchase the one supposing it to be the other.[4] The Respondent-Applicant was given ample opportunity to explain how it came up with its mark but despite the same, it did not file an Answer.

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[4] Societe des Produits Nestle,S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

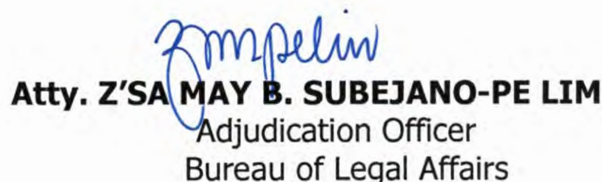
It is highly probable that the purchasers will be led to believe that Respondent-Applicant's mark is a mere variation of Opposer's mark and that its goods are associated with the latter especially that both marks cover pharmaceutical products under Class 05. Succinctly, it is settled that the likelihood of confusion, mistake and/or deception will subsist not only as to the consumer's perception of the goods but also on the origins thereof. Callman notes two types of confusion. The first is the confusion of goods "in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other." In which case, "defendant's goods are then bought as the plaintiff's, and the poorer quality of the former reflects adversely on the plaintiff's reputation." The other is the confusion of business: "Here though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff, and the public would then be deceived either into that belief or into the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist."[5]

Finally, it is emphasized that the essence of trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.[6] The Respondent-Applicant's mark fell short in meeting this function.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2010-004174 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 10 OCT 2016



Atty. Z'SA MAY B. SUBEJANO-PE LIM
Adjudication Officer
Bureau of Legal Affairs

[5] Societe des Produits Nestle, S.A. vs. Dy, G.R. No. 172276, 08 August 2010.
[6] Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.